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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Patent Application of

✓ Roger F. BAINES

Serial No.: ✓ 07/702,615

Filed: ✓ May 17, 1991

For: ELECTRIC MOTOR WITH BRUSH ASSEMBLY
SUPPORTING TWO SEPARATELY FORMED BRUSHES

New York, New York

Date: May 19, 1994

Group Art Unit: 2102

Examiner: R. Skudy

ap04

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

REPLY BRIEF AND REQUEST FOR ORAL HEARING

Sir:

Request for Oral Hearing

The applicants hereby request an oral hearing in this appeal. Enclosed is our check no. 41541 in the amount of \$230.00 in payment of the fee for the oral hearing.

This brief is being filed in triplicate.

Response to New Issues in Examiner's Answer

This is responsive to the new issues raised in the Examiner's Answer.

The Claims do not "Stand or Fall Together"

In Section (5) of the Examiner's Answer, the Examiner says: "The rejection of claims 5-7 and 9-42 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together." The Examiner referred to 37 C.F.R. 1.192(c)(5), but that section

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provides no support for his statement. That section provides that rejected claims will "stand or fall" together, unless the Appeal Brief contains a statement that the rejected claims do not stand or fall together, with reasons.

Page 4 of the Appeal Brief states:

"Each claim discussed below is considered to be independently patentable for the reasons stated. Any claims not discussed below will 'stand or fall' with the claims from which they depend."

The foregoing statement clearly satisfies 37 C.F.R. 1.192(c)(5) as a statement that the rejected claims do not necessarily "stand or fall" together. It furthermore acknowledges openly that certain unasserted claims will "stand or fall" together. Reasons for allowance are presented in the Appeal Brief from page 4 to page 15, as required by the regulation.

Summarizing the above, claims 5-7 and 9-42 do not "stand or fall" together. There is a statement to that effect in the Appeal Brief, as required. Each claim discussed in the Appeal Brief is considered to be independently patentable.

Examiner's Comments on the Appendix

We note the Examiner's suggested corrections to the Appendix of the Appeal Brief on page 3 of the Office Action in Section (6). However, the Appendix is correct. No corrections are required. Claim 7, line 5, reads "a DC motor" as stated in the Appendix. See the amendments dated February 6, 1993 and November 15, 1993. Likewise, "a single one" in claim 15, lines 9-10 is correct. See the Amendment dated February 6, 1993. Likewise, in claim 15, line 10, "a same time" is correct. See the Amendments dated February 6, 1993 and November 15, 1993.

Summarizing the above, the copy of the appealed claims in the appendix to the Appeal Brief is correct.

New Grounds for Rejection under
35 U.S.C. 112, First and Second Paragraphs

Section (9) on pages 3-5 of the Office Action contains new grounds for rejection.

Claims 7 and 15

The Examiner has presented a rejection of claims 7 and 10-42 under 35 U.S.C. 112, in Section (9) of the Examiner's Answer, running from page 3 to page 4, referring first to the above-mentioned passages in claims 7 and 15.

This is a new ground for rejection. In the final Office Action of May 14, 1993, the Examiner had objected to "the motor" and "the same time" in claims 7 and 15. In response, we changed "the" to --a--, which was our best interpretation of the terse grounds for rejection. We offered to interview the Examiner if further 112 issues remained. Now the Examiner wants "a" to be changed back to --the--. It is submitted that this is a new ground for rejection not necessitated by any action taken or not taken by the applicants.

The 35 U.S.C. 112 grounds for rejection have never been clear, and are only slightly clearer now. For example, in the final Office Action the Examiner objected to "the motor" in claim 7, giving no more details. "The motor" was recited at several points in claim 7, but the Examiner did not mention any line numbers. Only in the Examiner's Answer are any line numbers mentioned, indicating the specific change the Examiner wants in claim 7, which is the reverse of what he appeared to request in the final Office Action. Again, we had offered to interview the Examiner on any remaining 112 issues. An opportunity to amend and a two-month period for response should have been granted in the Examiner's Answer.

----- An Amendment After Appeal is being filed herewith. Entry is requested, on the ground that it will place the case in better condition for consideration by the Board of Appeals. We are doing our best to satisfy this Examiner's requirements. If

any 35 U.S.C. 112 issues remain after entry of this Amendment After Appeal, we respectfully request a new two-month period to amend the claims to place the application in better condition for consideration by the Board of Appeals.

Note that the Amendment After Appeal refers to the claims and line numbers in the Appendix to the Appeal Brief. It is believed this is the simplest and clearest way to amend the claims now that the appeal has begun.

We are also amending claim 15, lines 9 and 10, as newly required by the Examiner, although we believe the Examiner's requirements might tend to make the claim less clear, rather than more clear. The Examiner mechanically requires claims 15 to read "the single one of said segments," because its parent claim 7 recited "a single one of said segments". But it is potentially misleading to state that the first and second brush bodies contact "a single one" of the segments, and that the third and fourth brush bodies contact "the single one" of the segments.

That is an irrelevant idea, because the first and second brush bodies are diametrically opposed to the third and fourth brush bodies, as clearly disclosed in the application and as recited in claim 34, which depends from claim 15. If the Examiner's suggestion is adopted, claim 15 might tend to suggest that all four of the brush bodies contact "the" single one of the segments at the same time. That would not be a correct interpretation of claims 7 and 15. The point of those claims is that the third and fourth brush bodies are disposed for contacting any single one of the segments at the same time, and likewise the first and second brush bodies are disposed for contacting any single one of the segments at the same time.

Thus, although "a single one" in claim 15, lines 9-10, does not need revision, it is being revised as requested, in an attempt to satisfy this Examiner's requirements, in view of the above statement regarding the meaning of the claims.

The Examiner's new requirement to change "a same time" at claim 15, line 10, to --the same time-- is particularly

unjustified. In the final Office Action, at page 2, line 8, he objected to "the same time" in claim 15, saying it had "no antecedent basis". We changed it to "a same time" so it would no longer require any antecedent support in the preceding claims. Now he wants it to be changed back to "the same time". It is being changed as required, in order to attempt to remove issues from this case.

Claims 7, 10-13, 15, 16 and 37

The Examiner's objections to claims 7, 10-13, 15, 16 and 37 on pages 4, 7 and 8, although unjustified, are being accommodated in the Amendment After Appeal. The Examiner says "said first and second support arms" in claims 10-13 does not have proper antecedent basis. But clearly, that phrase is properly supported by "at least first and second resilient, electrically conductive support arms" (emphasis added) at claim 7, lines 3 and 4. The Examiner requires us to insert "resilient, electrically conductive" into each dependent claim. No regulation or custom requires such a hypertechnical amendment. Nevertheless, in the Amendment After Appeal we are making such changes in the hope of eliminating issues from this appeal. It is hoped that the Examiner's objections to claims 7, 10-13, 15, 16 and 37 have now been resolved.

Claims 17, 24, 28, 33 and 42

In contrast, the Examiner's objections to claims 17, 24, 28, 33 and 42 on page 4 of the Examiner's Answer are self-contradictory and are requested to be clarified or withdrawn. The Examiner objected to "said first support" in claim 17 at line 11, but did not object to "the supports" at line 8. Both of those phrases have antecedent basis at lines 3 and 4 of claim 17, which recites "first and second resilient, electrically conductive supports."

Why did the Examiner object to one but not the other? What is the objection? Apparently "said first support" is

objectionable, but "the supports" in the same claim is not objectionable. The grounds for such an inconsistent objection are unknown to the applicants, and must be made clearer than they are now. Thus the Examiner's objections to claims 17, 24, 28, 33 and 42 must be traversed.

Claim 7

Another new ground for rejection in this Examiner's Answer is the statement that the passage "a plurality of circumferential segments . . . connected electrically in parallel" in claim 7 is "insufficiently supported in the specification". This is a new ground for rejection, because there is no such rejection in the final Office Action. It must be traversed. The cited passage is fairly supported by the disclosure of the arrangement of the commutator 12, the two pairs of supporting parts 18 and 19, and the two pairs of brush bodies 20 and 21, as described at pages 3-6 and illustrated in Figures 1, 2, 3 and 3A, among other parts of the disclosure. It would be clear to a skilled individual that the quoted wording from claim 7 is readable on the disclosure. Nevertheless, in an effort to remove this new ground of rejection from the appeal, the Amendment After Appeal contains an amendment to the specification at page 4, following line 13, where language corresponding to claim 7 is being inserted. Therefore, this ground for rejection of claim 7 is requested to be withdrawn.

Conclusion

For at least the above reasons, the 35 U.S.C. 112 objections and rejections, on mixed grounds under para. 1 and para. 2, are requested to be either reversed or remanded to the Examiner.

Objections and Rejections under
35 U.S.C. 112, First Paragraph

In the section running from page 4 to page 5 of the Examiner's Answer, the Examiner objected to the specification and rejected claims 19-23 on the ground that the specification does not provide support for certain phrases in claims 19, 20, 22 and 23. The rejections are self-contradictory and therefore must be traversed. The Examiner refers to claims 19-23 as containing "new matter." But the Examiner but does not cite 35 U.S.C. 132. Is this a new matter rejection? Or is it simply a request for the specification to be amended to include the cited claim language? If the rejection had been made clear in the Examiner's Answer, we might have been able to respond to it in the Amendment After Appeal.

In any event, the claims 19-23 do not contain any sort of new matter. The limitations in those claims are adequately supported by the specification and drawings as originally filed, for the reasons already of record. Therefore, the rejections of claims 19-23 and objection to the specification under 35 U.S.C. 112, first paragraph, is requested to be reversed.

It is noted with appreciation that in the Examiner's Answer, the Examiner has withdrawn the 35 U.S.C. 112, first paragraph, rejections of claims 33, 37 and 38-40 that were presented in the final Office Action.

Prior Art Rejections

It is noted with appreciation that the prior art rejection of claims 24-33 has been withdrawn. After the Decision on Appeal, claims 24 and 32 may be rewritten in independent form, which will place claims 24-33 in allowable condition. It is noted further that claim 40 depends from claim 33. The Examiner is requested to acknowledge the allowability of claim 40 as well.

No new prior art issues are seen in the Examiner's rejection. The prior art still lacks any teaching that a pair of parallel brushes having different resonant frequencies should be placed on the same side of a rotating commutator.

Conclusion

For the foregoing reasons, the Board is requested to reverse the rejections based on the prior art.

Regarding the 35 U.S.C. 112 objections and rejections, the Board is requested to either reverse them or remand them to the Examiner.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on May 19, 1994:

James A. Finder

Name of applicant, assignee or
Registered Representative



Signature

May 19, 1994

Date of Signature

Respectfully submitted,



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